

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has characterized the invention of Groups I and III as representing “separate and patentably distinct inventions.” M.P.E.P. § 802.01 states that “distinct” inventions must be shown to be related “but are capable of separate manufacture, use, or sale as claimed AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER”. Applicants respectfully submit that the Office has merely stated a conclusion, and failed to provide any evidence and/or examples to show that the inventions of Groups I and III are “novel and unobvious” over each other, *and* “capable of separate manufacture, use, or sale”. Accordingly, Applicants fail to see how the inventions of Groups I and III can be “distinct” as defined in MPEP § 802.01. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office has characterized the inventions of Groups II and III as related as process of making and product made. Citing MPEP § 806.05(f), the Office concludes that the product as claimed “may be made by another and materially different process, such as coating a die on a substrate then covering the die with the claimed compound.” However, there is no evidence of record to show that the claimed product can be made by “coating a die on a substrate” as the Office has alleged. If, in fact, the claimed product can be made by “coating a die on a substrate”, Applicants respectfully submit that the Office has not shown how this proposed process is materially different from the claimed process. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

Finally, the Office states that the inventions of Groups II and I “represent separate and patentably distinct inventions” because “the process in group I is not used to make the

product in group II.” The Office then concludes that “each of these groups would therefore be able to support their own patent.” However, as discussed above, M.P.E.P. § 802.01 states that “distinct” inventions must be shown to be related “but are capable of separate manufacture, use, or sale as claimed AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER”. Applicants respectfully submit that the Office has merely stated a conclusion, and has failed to provide evidence and/or examples showing that the inventions of Groups I and II are “novel and unobvious” over each other, *and* “capable of separate manufacture, use, or sale”. Accordingly, Applicants fail to see how the inventions of Groups I and II can be “distinct” as defined in MPEP § 802.01. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore respectfully request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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